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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,578	07/17/2003	W. Gregg Sterling	307-101P-WLK	8854

7590

04/12/2005

Law Offices of William L. Klima, P.L.C.
P.O. Box 2855
Stafford, VA 22555-2855

EXAMINER

SMITH, JAMES G

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/620,578	Applicant(s) STERLING ET AL.	
	Examiner James G Smith	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-9,13-19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. The indicated allowability of claim 18 if rewritten in independent form including all the limitations of the bas claim and any intervening claims is withdrawn in view of the newly discovered reference(s) to Larkin et al. (2,697,007) and Crews (D502,588). Rejections based on the newly cited reference(s) follow.

Specification

2. The uses of the trademarks GREEN BAY PACKERS, NATIONAL FOOTBALL LEAGUE, DAYS OF THUNDER, DIRECTV, KEVLAR, and STYROFOAM have been noted in this application. Each should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

3. Claim 19 is objected to because of the following informalities: The term Indy Car in the Claim language could be easily confused with the now trademarked INDYCAR (no space). Its removal from the Claim would avoid the possible confusion. Appropriate correction is required.

Drawings

4. The brand GOODYEAR forming part of the claimed design is a registered trademark of The Goodyear Tire & Rubber Company. The specification must be amended to include a

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statement preceding the claim identifying the trademark material forming part of the claimed design and the name of the owner of the trademark.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 17 contains the trademark/trade name VELCRO. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe hook and loop fasteners and, accordingly, the identification/description is indefinite.

8. Claim 19 contains the trademark/trade name NASCAR. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark

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or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe stock car racing and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-9, 13-17, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larkin (2,697,007) in view of Lawson (D420,206) and Crews (D502,588). With respect to Claims 1, 19, 21, and 22, Larkin discloses a hat with a foam ring that receives the wearer's head in a central recess orienting the ring transversely about the wearer's head. While Larkin does not simulate a tire on the wearer's head novelty hats of the like are well known as shown in the Lawson and Crews patents. Crews illustrates a tire hat that is printed to visually simulate a vehicle tire with a sidewall and treads. The smooth edge about the entire periphery of the hat in FIG. 1 is indicative of a smooth printed surface rather than a molded surface to simulate the vehicle tire treads. Lawson illustrates a simulated tire mounted on a wheel that is worn oriented transversely about the wearer's head. With respect to Claims 2 and 3, Lawson and Crews each visually simulate a tread portion and at least one sidewall portion of a vehicle tire. With respect to Claim 4, 5, and 6, Lawson is configured to receive the top portion of a wearer's head in the center of the tire. With respect to Claim 7, the visually simulated vehicle tires disclosed by both Lawson and Crews would require at least one method from the group consisting of printing, screen printing, painting, air brushing, coloring, shading, and dying. With respect to Claims 8

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and 9, the visually simulated vehicle tires disclosed by both Lawson and Crews would require at least one method from the group consisting of cutting, molding, contouring, shaping, forming, and tailoring. With respect to Claim 13, the outer fabric layer is removable from the inner hat portion. With respect to Claims 14-17, the toric-shaped cover is removably attached to the inner hat portion with snap fasteners 44 as shown in FIG. 2. Zippers, buttons, hooks, or similar means are disclosed as acceptable attachment means. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Lawson and Crews with the hat structure of Larkin to create a novelty hat that visually simulates a vehicle tire.

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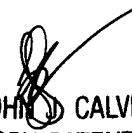
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James G Smith whose telephone number is 571-272-4994. The examiner can normally be reached on 8:00-5:00, off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J Calvert can be reached on 571-272-4983. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS
4/6/2005


JOHN J. CALVERT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700